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MAILED

DEC 16 2010

PCT LEGAL ADMINISTRATION

In re Application of :
WERNER *et al* :
U.S. Application No.: 10/585,215 :
PCT No.: PCT/DE2005/000372 :
Int. Filing Date: 03 March 2005 :
Priority Date: 03 March 2004 :
Docket No.: 17346-0088 :
For: USE OF A METAL COMPLEX AS AN :
N-DOPANT FOR AN ORGANIC :
SEMICONDUCTING MATRIX :
MATERIAL, ORGANIC OF :
SEMICONDUCTING MATERIAL AND :
ELECTRONIC COMPONENT, AND :
ALSO A DOPANT AND LIGAND AND :
PROCESS FOR PRODUCING SAME :

DECISION

This decision is in response to applicants' renewed petition under 37 CFR 1.47(a) filed 01 November 2010.

BACKGROUND

On 30 August 2010, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants were given two months to respond with extensions of time available.

On 01 November 2010, applicants filed the subject response which was accompanied by, *inter alia*, documentary evidence in support of the petition (Exhibits 1 - 2), and a declaration executed by one of the named inventors.

DISCUSSION

In the renewed petition, applicants claim that Olaf KÜHL "could not be found or reached despite a diligent effort to do so." In the original petition, applicants asserted that the nonsigning inventor refused to cooperate.

As previously stated, a petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf

and on behalf of the nonsigning joint inventor.

Items (1) and (3) of 37 CFR 1.47(a) were completed in the original petition.

Regarding item (2) of 37 CFR 1.47(a), applicants resubmitted the letter from Mr. Volker Scholz dated 20 February 2009 along with copies of the German postal receipts. Applicants included translations of three phrases listed on the German postal receipts (two of which were listed in the letter by Mr. Scholz). Applicants claim that this evidence shows that Mr. KÜHL could not be found or reached despite a diligent effort to do so.

It is first noted that the objections listed in the decision mailed 30 August 2010 regarding a refusal to cooperate are still valid. With regards to applicants claim that the evidence shows that the nonsigning inventor cannot be reached, MPEP § 409.03(d)(I) of the MPEP discusses these situations, and states, in relevant part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47(a) . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In the present case, applicants have not shown that a diligent effort was made to locate Mr KÜHL for the following reasons.

The letter by Mr. Scholz dated 20 February 2009 is not considered to meet the MPEP requirements that an affidavit or declaration of the facts be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. Moreover, applicants have shown only that documents were sent to the last known address of Mr. KÜHL, but that they were not delivered after two attempts. Apparently no further attempts were made.

In addition, applicants have not shown whether that address was still valid for Mr KÜHL, or whether the nonsigning inventor was on vacation, or out of town. There was also no evidence that a search of any type was made to locate Mr KÜHL.¹ Applicants have also not provided a copy of the cover letter as required as relevant evidence, and previously discussed in the prior decision.

For these reasons, item (2) of 37 CFR 1.47(a) is not yet complete. Counsel is invited to contact the undersigned for further guidance to satisfy this requirement, if necessary.

Concerning item (4) of 37 CFR 1.47(a), applicants submitted a declaration signed by co-inventor Kentaro HARADA. This declaration lists only one inventor. The above-captioned application has eight inventors.

This declaration does not meet the requirements of 37 CFR 1.497(a)(3), and is not accepted. For this reason, item (4) of 37 CFR 1.47(a) is still not satisfied.

CONCLUSION

For the reason discussed above, applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extension of time under 37 CFR 1.136(a) is available.

Any further correspondence may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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¹ Such attempts could include internet searches for addresses, telephone numbers and email addresses. Contacting former employers and/or co-workers to obtain new contact information for Mr KÜHL would also be appropriate. These efforts are not extraordinary and are required to show that a diligent effort was made to contact the inventor.